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5-23-01**RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2176**

Due Date: May 22, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Howard J. Glaser et al. Examiner: W. Bashore
Serial No.: 09/162,685 Group Art Unit: 2176
Filed: September 29, 1998 Docket: ST9-98-052
Title: HTML MAPPING SUBSTITUTION GRAPHICAL USER INTERFACE FOR
DISPLAY OF ELEMENTS MAPPED TO HTML FILES

OFFICIAL**CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 308-6306 on May 18, 2001.

By: *Victor G. Cooper*
Name: Victor G. Cooper

PETITION UNDER 37 C.F.R. §1.181

BOX AF
Commissioner for Patents
Washington, D.C. 20231

RECEIVED
5/21/01

Dear Sir:

This Petition is being submitted in accordance with M.P.E.P. §706.07(c) to invoke the supervisory authority of the Commissioner under 37 C.F.R. §1.181 involving an ex parte action in the above-identified patent application that is not subject to appeal and not otherwise provided for.

The Applicants request a review of the final rejection made in an Office Action dated March 22, 2001, for the above-identified patent application. This Petition is being submitted in response to the final office action.

The 35 U.S.C. § 103 rejections in the Office Action were made final, even though the rejections of the Office Action were based on a reference that was not cited in a previous Office Action on the

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application and the amendments made to the claim merely incorporated claim limitations expressed in a dependent claim. The Examiner asserted that the Applicants' amendment necessitated the new grounds of rejection.

The Applicants' attorney disagrees. The Applicants' amendment of the claims merely amended the independent claims to incorporate dependent claim limitations. For example, the independent claims 1, 12, 23 were amended to include a limitation such that the element was transferred from a from to an HTML page and an HTML file associated with the HTML page, which limitation was incorporation from dependent claims 2, 13, and 24 respectively of the application as originally filed. The original dependent claims 2, 13, and 24 specifically provided "...the element is transferred from a from to the HTML page associated with the HTML file."

The amendments and arguments made in response to the first Office Action should reasonably have been expected by the Examiner, since the subject of the amendments were part of the specification and, more importantly, part of the claimed subject matter, of the application as originally filed. See M.P.E.P. §§ 706.07(a) and 904 et seq.

As such, it is respectfully submitted that the rejections should not be made final because the rejections of the second Office Action include rejections made on prior art not of records, and consist solely of included limitations which should reasonably have been expected to be claimed. As a result, it is erroneous, as a matter of law, to state that the Applicants' amendments were not reasonably expected by the Examiner and therefore necessitated the new grounds of rejection. Consequently, the final rejection was premature, and Applicants' attorney respectfully requests its withdrawal.

This Petition is being submitted by facsimile, and thus Applicants request that any required Petition fees be charged to the Deposit Account No. 09-0460 of IBM Corporation. Any other fees should be charged to Deposit Account No. 09-0460 as well.

Respectfully submitted,

Howard J. Glaser et al.

By their attorneys,

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Date: May 18, 2001

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